UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/851,480 | 05/09/2001 | William T. Florence | 18360/234317 | 3771 |

826 7590 11/06/2009

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

| EXAMINER | |
|---|---|
| JEANTY, ROMAIN | |
| **ART UNIT** | **PAPER NUMBER** |
| 3624 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 11/06/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/851,480
Filing Date: May 09, 2001
Appellant(s): FLORENCE, WILLIAM T.

Jennifer F. Miller
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 16, 2007 appealing from the Office action mailed June 16, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

## NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 4, 9, 11, 16, 21, 24, 29, 30 and 40** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 70 (1972); Diamond v. Diehr, 450 U.S. 192 (1981); Parker v. Flook, 437 U.S. 589 n.9 (1978); and Cochrane v. Deener, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (Benson, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see In re Bilski, No. 2007-1130, _F.3d_, 2008 WL4757. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101. In the present case, claims 1, 4, 9, 11, 16, 21, 24, 29, 30 and 40 recite a method comprising steps without tie to another statutory class is directed to software/data per se and is non-statutory subject matter. Note that the tie to another statutory class should be in the body of the claim.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,085,170 | TSUKUDA | 7-2000 |
| 6,879,962 | SMITH | 4-2005 |
| Competency | DAVID | 10-1999 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims: The ground(s) for rejection are reproduced below from the Final Office Action, and are provided here for the convenience or both the Appellant and the Board of Patent Appeals:

**Claim Rejections - 35 USC 103**

Claims 1, 4, 9, 11, 16, 24, 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukuda (US Patent No. 6,085,170) in view of David (Core Competency).

As per c1aims 1, 9, 16, most delivery systems provide time windows for recipient to receive particular items (i.e., the time window may be the days of the week or weekends). Overlapping time windows are time periods within a given day. System for providing a delivery time is well known in the art. For example, Tsukuda discloses a delivery system for managing delivery of goods from a distribution center. In so doing, Tsukuda discloses a delivery managing system in which an individual may choose a delivery time with the obvious difference that receiving choices from a plurality of overlapping time windows are not made by a recipient. David teaches a system in which a customer (the examiner interprets

the customer as "recipient") selects a delivery date. It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Tsukuda to include an overlapping time window being selected by a recipient/customer as evidenced by David in order to allow a recipient to receive a particular package at a time that would be available to receive it.

As per claims 2, 10, Tsukuda does not expressly disclose providing each recipient with a plurality of time windows that include at least two sequential time windows and at least one overlapping time window that overlaps a portion of each of the sequential time windows. However, Tsukuda discloses the date and time for scheduling a delivery (col. 5, lines 26-46). In addition, David teaches a system in which a customer. It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Tsukuda to include an overlapping time window being selected by a recipient as evidenced by David in order to allow a recipient to receive a particular package at a time that would be available to receive it.

As per claims 4, 11, Tsukuda does not expressly disclose providing each recipient with a plurality of time windows that include at least two sequential one-hour time windows and at least one overlapping time window that overlaps each of the sequential time windows by one-half hour. However, Tsukuda discloses the date and time for scheduling a delivery (col. 5, lines 26-46). In addition, David teaches a system in which an overlapping time is used (i.e. the time can be half-hour, 1 hour, 1.5 hour, 2 hours, 2.5 hours, etc). Note entire page 2 of David. It would have been obvious to a person of ordinary skill in the art to modify the

disclosures of Tsukuda to include an overlapping time window being selected by a recipient as evidenced by David in order to allow a recipient to receive a particular package at a time that would be available to receive it.

As per c1aims 24 and 40, most delivery systems provide time windows for recipient to receive particular items (i.e., the time window may be the days of the week or weekends). Overlapping time windows are time periods within a given day. System for providing a delivery time is well known in the art. For example, Tsukuda discloses a delivery system for managing delivery of goods from a distribution center. In so doing, Tsukuda discloses a delivery managing a delivery system in which an individual may choose a delivery time with the obvious difference that receiving choices from a plurality of overlapping time windows are not made by a recipient. David teaches a system in which a customer (the examiner interprets the customer as “recipient”) selects a delivery time within a window. Tsukuda further teaches an Internet (most Internet system comprises of a webpage). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Tsukuda to include an overlapping time window being selected by a recipient/customer as evidenced by David in order to allow a recipient to receive a particular package at a time that would be available to receive it.

As per claim 29, Tsukuda disclose a scheduling engine to determine whether a maximum number of orders to be delivered within one of said plurality of time windows has been reached (i.e., list of the scheduled date and time for delivery) (col. 5, lines 15-25).

Claims 20-21, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukuda (US Patent No. 6,085,170) in view of David (Core Competency) and further in view of Smith et al "Smith" (US Patent No. 6,879,962).

As per claims 20, 21 and 30, the combined references of Tsukuda and David does not expressly disclose determining which time windows of said plurality have associated with them the least cost of service in making the delivery and determining whether the cost of delivering the item within a time window of said plurality is less than a monetary threshold. Smith in the same field of endeavor discloses the concept of a least cost of service in making a delivery (col. 2, lines 33-46). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Tsukuda and David to incorporate the teachings of Smith in order to determine a minimum cost of delivering a package.

**35 U.S.C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

**Claims 1, 4, 9, 11, 16, 21, 24, 29, 30 and 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 70 (1972);**

**Diamond v. Diehr, 450 U.S. 192 (1981); Parker v. Flook, 437 U.S. 589 n.9 (1978); and Cochrane v. Deener, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (Benson, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see In re Bilski, No. 2007-1130, _F.3d_, 2008 WL4757. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101. In the present case, claims 1, 4, 9, 11, 16, 21, 24, 29, 30 and 40 recite a method comprising steps without tie to another statutory class is directed to software/data per se and is non-statutory subject matter. Note that the tie to another statutory class should be in the body of the claim.**

**(10) Response to Arguments**

Appellant argues that the claimed feature is not present in the prior art. However, the examiner interprets this feature as a customer desiring a product to be delivered in a particular month and during the first two weeks or last two weeks of that particular month. The sequential time windows are the month and the overlapping windows are the week. So, this is similar to applicant's claimed invention, and the examiner finds no patentable subject matter apart from this interpretation. Thus, it would have been obvious to a person of ordinary skill in

the art to note this obvious difference merely as a change in language when viewing the Tsukuda and David references.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. J./
Primary Examiner, Art Unit 3623

**Bank of America Plaza**
**101 South Tryon Street, Suite 4000**
**Charlotte, NC 28280-4000**

Conferees:

/Vincent Millin/
Appeal Specialist

/Alexander Kalinowski/
SPE 3691